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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,515	03/12/2004	Michael A. Bailey	133226 SAR-62	6126
34132	7590	05/02/2007		
COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19103-3508			EXAMINER HARLAN, ROBERT D	
			ART UNIT	PAPER NUMBER
			1713	
			MAIL DATE	DELIVERY MODE
			05/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,515	<b>Applicant(s)</b> BAILEY ET AL.	
	<b>Examiner</b> Robert D. Harlan	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-14 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-14 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The Amendment and Ceska Declaration filed by Applicant on 02/27/2007 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 1-7, 9-14 and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ceska et al., U.S. Patent No. 6,399,672 (hereinafter "Ceska"). Ceska teaches a curable adhesive comprising at least one oil-soluble metal compound prepared by reaction of metal compound with acid functional compound wherein the oil-soluble metal compound is polymerized with a (meth)acrylate monomer in the presence of a free radical initiator. Ceska, col. 3, lines 5-25; col. 7, lines 44-62. After a closer examination of the claims, Ceska clearly teaches a resin composition prepared by copolymerizing, in the absence of radiation conditions, an alpha, beta ethylenically unsaturated monomer with an oil soluble metal salt prepared reacting (A) with (B) which is a reaction product of (1) and (2). The outstanding issue is whether Ceska teaches a resin composition exhibiting reversible cross-linking behavior. Of course, Ceska does not have a direct teaching of a resin composition exhibiting reversible cross-linking behavior. However, to one of ordinary skill in the art, Ceska does teach a substantially identical resin composition prepared from a substantially identical copolymerization. In fact, the teachings of Ceska are substantially identical to the claimed invention that the Examiner contends that the missing limitation: a resin composition exhibiting reversible cross-

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linking behavior is inherent. See In re Best, 195 USPQ 430 (CCPA 1977); In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

5. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessary make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. The Examiner reasons that if a polymer is prepared by a known process, then the polymer itself and its properties are known as well. The Examiner finds nothing in the disclosure of Ceska that would suggest that the properties of the resin compositions are different from the properties of the claimed resin compositions. Furthermore, it still would have been obvious to one of ordinary skill in the art to arrive at the claimed resin compositions, because it appears that the claimed resin compositions are within the generic disclosure of Ceska and a person of ordinary skill in the art would have expected all embodiment of Ceska to have similar properties. The evidence presented to rebut the prima facie case of obviousness must be commensurate in scope with the claims to

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which it pertains. See In re Dill and Scales, 202 USPQ 805 (CCPA 1979).

6. Although the Ceska Declaration states that none of the Examples presented in the Ceska reference would exhibit such reversible crosslinking behavior because all of the examples would have included covalent crosslinking. A person of ordinary skill would be motivated to reach a different assertion because Ceska makes clear soluble zinc and calcium salts of ethylene glycol-methacrylate-phthlate (EMD) prepared in aqueous solution and copolymerized with MMA, ST and HEMA were disclosed as ionic crosslinkers. See Ceska, col. 1, lines 34-43. Ceska further teaches other soluble zinc and calcium salts, which the Examiner will presume are ionic. In addition, nowhere is Ceska does it state the soluble zinc and calcium salts are "covalent" crosslinkers. Thus taking the Ceska Declaration into consideration, there is nothing in Ceska that specifically and explicitly state the soluble zinc and calcium salts are covalent. To the contrary, throughout the Ceska reference, Ceska teaches soluble zinc and calcium salts that are ionic crosslinkers ("Matsuda" references).

**Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

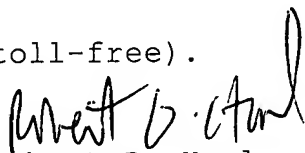
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Harlan whose telephone number is (571) 272-1102. The examiner can normally be reached on Mon-Fri, 10 AM - 8 PM.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be

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reached on (571) 273-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Robert D. Harlan  
Primary Examiner  
Art Unit 1713

rdh